

REMARKS

Summary of Changes Made

By this Amendment, claims 1, 11-14, 16-20 and 22 have been amended, and claims 2, 4, 15, and 21 have been canceled. Claims 1, 13, 14, 17-20 and 22 have been amended to replace the limitation "polar powder" with the limitation "graphite powder." Claims 11, 12 and 16 have been amended to correct spelling or usage errors. The application was originally filed with claims 1-22. Accordingly, claims 1, 3, 5-14, 16-20 and 22 (19 claims) remain pending in the application. No new matter is added by this Amendment.

Claim Rejections - 35 U.S.C. §102 (Double Patenting)

The Examiner has rejected claims 1-12 and 17-22 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-14, 16, 19 and 20 of U.S. Pat. No. 6,679,935 ("the '935 patent").

The Examiner will note that a terminal disclaimer is enclosed herewith. The terminal disclaimer disclaims any terminal portion of any patent that issues from the present application, which extends beyond the expiration date of the '935 patent, i.e., August 12, 2022. In light of the enclosed terminal disclaimer, it is believed the double patenting rejection is moot.

Claim Rejections - 35 U.S.C. §112 ¶ 2

Claim 9 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner contends that the limitation "fatty acid material" has insufficient antecedent basis.

The Examiner will note that claim 9 has been amended to depend from claim 5, which contains proper antecedent basis for the limitation "fatty acid material." It is thus believed the rejection is moot.

Claim Rejections - 35 U.S.C. §102(e) (Schofalvi)

Finally, the Examiner rejected claims 1, 2, 5-8 and 10-22 under 35 U.S.C. § 102(e) as anticipated by Schofalvi et al., U.S. Pat. App. Pub. No. 2003/0220424, ("Schofalvi"). The

Examiner asserts that Schofalvi discloses a composition for powder metallurgy comprising an inorganic powder, a binder composition, which comprises an aliphatic polyester polymer, an ethylenebisamide wax, and a guanidine wetting agent, as well as a debinding accelerator. The Examiner believes the binder composition and the debinding accelerator of Schofalvi reads on the instantly claimed lubricant system and polar powder.

Further, the Examiner asserts: that the limitations of instant claims 2 and 15 are disclosed in paragraph 82 of Schofalvi; that the limitation of claim 5 is disclosed in paragraph 40; that the limitation of claim 7 is disclosed in paragraph 78; that the amide wax of claim 8 reads on the disclosed ethylenebisamide wax; that the limitations of claims 10-12 are disclosed in paragraphs 41-43; and the properties recited in claims 14 and 16 are inherent in the prior art because the compositions are the same. With respect to claim 17, Schofalvi discloses the limitation in paragraphs 149-160. Looking to claims 18-20, the Examiner asserts that Schofalvi teaches the same method employing the same material, so the claimed polar powder would inherently possess the same properties. Finally, with respect to claim 22, the Examiner states that Schofalvi discloses 1-10 vol % of binder, and believes that this range overlaps that recited in claim 22.

The Examiner will note that claims 2, 15, and 21 have been canceled, and that independent claims 1, 13, 17, and 22 have been substantively amended to address the rejection (even though applicant respectfully submits that Schofalvi does not anticipate because it concerns a binder system, not a lubricant system as claimed by the present application). Specifically, independent claims 1, 13, 17 and 22 have been amended to specify the presence of graphite powder. The cited Schofalvi reference neither discloses nor suggests the use of a graphite powder. It is respectfully submitted that claims 1, 13, 17 and 22, as amended, are novel and nonobvious over the cited prior art reference. For the same reasons, dependent claims 3, 5-14, 16 and 18-20, all of which ultimately depend from independent claims 1, 13 and 17 are similarly asserted to be patentable over Schofalvi.

CONCLUSION

Based on the foregoing, the Applicants respectfully request entry of the instant amendment and a Notice of Allowability for claims 1, 3, 5-14, 16-20 and 22.

If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application. If there are any additional fees resulting from this communication, please charge the same to our Deposit Account No. 18-0160, our Order No. APX-12571.001.

Respectfully submitted,

RANKIN, HILL, PORTER & CLARK LLP



Kenneth A. Clark
Reg. No. 32,119
Christopher J. Korff
Reg. No. 55,342

925 Euclid Avenue
Suite 700
Cleveland, Ohio 44115-1405
(216) 566-9700